

REMARKS

Claims 1-34 are pending in this application and claims 15-29 have been subjected to a restriction requirement and withdrawn from consideration. Applicant previously submitted an amendment under 37 C.F.R. § 1.116 on November 6, 2003 that was not entered.¹

The Restriction Requirement

Applicant acknowledges the finality of the restriction requirement and withdrawal of claims 15-29 from examination.

Rejection - 35 U.S.C. § 112 ¶ 2

Applicant appreciates the withdrawal of this rejection.

The Pending Rejections

1. The Office has maintained the rejection claims 1-14 and 30-34 under the doctrine of obviousness-type double patenting over the claims of several co-pending applications in view of Erwin et al. (U.S. Patent No. 3,755,037) for the reasons listed on pages 2-3 of the Advisory Action

2. The Office has also maintained the provisionally rejection of claim 8 under the doctrine of obviousness-type double patenting over the claims of several co-pending applications in view

¹ The Advisory Action of November 21, 2003, did not indicate whether that after-final amendment was entered or not entered. Applicant discovered that the after-final amendment was not entered in an unofficial telephone interview with the Examiner.

of Erwin et al. and further in view of Reid et al. (U.S. Patent No. 6308809) for the reasons listed on pages 2-3 of the Advisory Action.

3. The Office has maintained the rejection of claims 1-7, 9-14, and 30-34 under 35 U.S.C. § 102 (b) as being anticipated by Erwin et al. for the reasons listed on pages 2-3 of the Advisory Action.

4. The Office has maintained the rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Erwin et al. in view of Reid et al. for the reasons listed on pages 2-3 of the Office Action.

The Office's Position

Despite Applicant's previous arguments, the Office maintained the above rejections for two reasons. First, the Office argues that the reinforcing strips 44 of Erwin et al. constitute a composite overwrap. Second, the Office has not considered the claim limitation that the composite overwrap "reduces a secondary loading condition" because it is an intended use and have been given little to no patentable weight.

Applicant respectfully disagrees with both of these reasons. The reasons why the Office has not shown that Erwin et al. disclose a composite overwrap are discussed below. As to the second reason, the claim limitation that the composite overwrap reduces the secondary loading condition is not an intended use. An "intended use" limitation recites just that: a use that is intended. For example, a composite overwrap that "can be used" to reduce the secondary loading condition would be an intended use.

The claim limitation under discussion, however, does not recite such an intended use. Rather, this claim limitation positively recites an actual result: a reduction in the secondary

loading condition. Such a recitation is, therefore, an actual result and not an intended use and must be given patentable weight.

Composite Overwrap

The independent claims currently recite either that the structural member contains (1) a composite overwrap, (2) a composite overwrap collar, or (3) a composite overwrap where the composite fibers of the overwrap are oriented circumferentially around the polygonal outer surface. The Office has not shown that Erwin et al. either teach or suggest any of these limitations.

1. **A Composite Overwrap.** Inherent from its usage, a composite "overwrap" is a component that is "wrapped over" the outer surface. Thus, the limitation recites that this component must be "wrapped" in some manner. The Office, however, has not shown that the reinforcing strips 44 are wrapped in any manner.

Erwin et al. disclose that the reinforcing strips 44 are for the handle of a tennis racket. The tennis racket is made by a molding process using two mold halves as shown in Figures 4-5. *See also column 3, line 43-44.* The cross-section of a mold half containing the components for the tennis racket is illustrated in Figure 8. *See column 3, line 60 through column 4, line 2.*

The reinforcing strips are made by placing one end of the strips 44 in the first mold half so that, as illustrated in Figures 4 and 5, the strips extend out one side of the mold. *See also column 4, line 13-15.* Then the various components of the tennis racket are placed in the first mold half and the other end of the strips 44 are "folded back" over the various components of the handle. The second mold half is then placed on the first mold half to complete the mold. *See column 4, line 25-28.* The tennis racket is then completed by a molding process so that the

reinforcing strips run along the length of the handle as depicted in Figures 4 and 5. The Office has not shown that such longitudinal reinforcing strips are wrapped over or around the various components of the handle.

2. A Composite Overwrap Collar. Based on this claim language, the skilled artisan would understand that the composite overwrap is in the form of a collar. The Office, however, has not shown that the reinforcing strips 44 of Erwin et al. are in the form of a collar. Indeed, based on the manner in which they are formed, it would be difficult to show that the reinforcing strips are in the form of a collar since they run lengthwise along the handle.

3. A Composite Overwrap With Circumferentially Oriented Fibers. Based on this claim language, the skilled artisan would understand that the composite fibers in the overwrap are circumferentially oriented around the structural member. The Office, however, has not shown that the reinforcing strips 44 of Erwin et al. contain fibers with such an orientation. Indeed, based on the manner in which they are formed, it would be extremely difficult for the Office to substantiate that Erwin et al. teach or suggest such a limitation.

Thus, the Office has not substantiated a sufficient basis for these grounds of rejection and Applicant respectfully requests withdrawal of these rejections.

JUL. 22. 2004 12:59PM

KIRTON & MCCONKIE

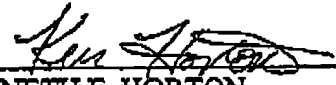
NO. 27546. oSP. 1590
Attorney Docket No. H-199376

CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the pending grounds of rejection and allow the claims, as amended.

If there is any fee due in connection with the filing of this Amendment, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 50-0843.

Respectfully Submitted,

By 
KENNETH E. HORTON
Reg. No. 39,481

Date: February 2, 2004

CUSTOMER NUMBER

27966

PATENT TRADEMARK OFFICE